

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-2 were pending in this application when last examined and stand rejected.

Claim 1 is amended to clarify the claimed method steps as supported by the disclosure at page 3, lines 24-29, page 5, lines 6-21, and original claim 2.

Therefore, no new matter has been added by this amendment.

Claim 2 is cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claim 1 is pending upon entry of this amendment.

II. INFORMATION DISCLOSURE STATEMENT

In item 1 on page 1 of the Office Action, it was indicated that the references cited in the Information Disclosure Statement (IDS) of June 25, 2005 were not considered, because copies of the references were not included.

It is respectfully submitted that the references were forwarded to the PTO by the International Bureau. Thus, kindly review the application file for these references and return an Examiner-initialed copy of the IDS indicating that the references have been officially considered.

III. INDEFINITENESS REJECTION

In items 3-4 on page 2-3 of the Office Action, claims 1-2 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

This rejection is respectfully traversed as applied to the amended claim.

Claim 1 is amended to clarify when the external stimulus is applied by incorporating the subject matter of claim 2. Specifically, the external stimulus is applied for a given period during which the primary signal occurs. After the stimulus, the secondary signal is observed. It is respectfully submitted that this amendment clarifies when the external stimulus is given.

In view of the above, the rejection of claims 1-2 under 35 U.S.C. § 112, second paragraph, is untenable and should be withdrawn.

IV. ANTICIPATION REJECTION

In items 6-7 on pages 3-4, claims 1-2 were rejected under 35 U.S.C. § 102(b) as anticipated by Medina, Biotechnology Techniques, Vol. 11, No. 3, pp. 173-176 (1997).

This rejection is respectfully traversed as applied to the amended claim.

To anticipate a claim, a cited prior art reference must teach each and every element of the claimed invention. See M.P.E.P. § 2131.01.

Amended claim 1 is directed to a method for evaluating the physiological activity of an external stimulus on living cells by means of a surface plasmon resonance analyzer, which comprises: (1) immobilizing the cells on a surface plasmon resonance analyzer; (2) applying the external stimulus to the cells; (3) continuously measuring a primary signal which appears upon application of the external stimulus, and measuring a secondary signal after elimination of the external stimulus; and (4) evaluating the physiological activity of the external stimulus on the cells with an indication of the secondary signal.

Medina fails to disclose or suggest "measuring a secondary signal after elimination of the external stimulus."

Instead, Medina relates to evaluating an antibody's effect by measuring a primary signal caused by the binding of the antibody to the cell surface of bacterial cells immobilized on a plasmon resonance biosensor. Medina never discloses or suggests measuring a secondary signal after a separation of the antibody from the cells. Accordingly, Medina fails to disclose or suggest

the claim step of "measuring a secondary signal after elimination of the external stimulus."
Consequently, Medina fails to disclose each and every element of the claimed invention. Thus, Medina cannot anticipate the claimed invention.

In view of the above, the rejection of claims 1-2 under 35 U.S.C. § 102(b) is untenable and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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